

**REMARKS**

This application pertains to a novel hotmelt pressure sensitive adhesive, which is characterized by a low shrinkback after extrusion coating.

Claims 1 to 5 and 7-29 are pending; claim 6 being canceled by this amendment. The limitations of claim 6 have been added to claim 1. Claims 10-15 and 18-29 have been withdrawn from consideration as drawn to a non-elected invention, so that the claims under examination are claims 1-5, 7-9 and 16-17.

The Examiner has imposed a Restriction Requirement between Claims 1-17, drawn to the adhesive (denoted Group I by the Examiner), Claims 18-21, drawn to a process for preparing the adhesive (denoted Group II by the Examiner) and Claims 22-29, drawn to an adhesive tape made with the adhesive (denoted Group III by the Examiner). Applicants provisionally elected the invention of Group I, and elected the species wherein the polyacrylate comprises at least one acrylic monomer, with traverse. Claims 1-9, 16 and 17 were identified as the claims reading on the elected invention and species. Applicants now affirm said elections, with traverse.

Reconsideration and withdrawal of the restriction requirement is respectfully requested. Any search of the adhesive is certain to include a search of the process for preparing it and adhesive tapes made with the adhesive.

Each of the three groups designated by the Examiner are so closely related that no additional burden could possibly be placed on the Patent Office in searching them all

together. In fact, it would be almost impossible to search any one of them without necessarily searching the others at the same time. By contrast, a very great burden will be placed on Applicants if this restriction requirement is maintained. Applicants will be subjected to three times the cost and effort in prosecuting three separate patent applications for an invention that should have been included in one, and will also be subjected to the continuing expense of maintaining three separate patents, whereas only one should be required to cover the full invention.

In addition, a great burden will be placed on the public, in that the full scope of Applicants' exclusive rights will not be ascertainable from a single patent, and the public will have to find and study three separate patents to ascertain the full scope of Applicants' exclusive rights.

The great additional burden that will be placed on Applicants and the public in maintaining the restriction requirement is far greater than the slight, if any, burden that will be placed on the Patent Office in withdrawing the restriction requirement.

It is therefore respectfully requested that the Restriction Requirement be withdrawn.

In the event that the Examiner does not find it possible to withdraw the Restriction Requirement, it is respectfully requested that the non-elected subject matter be rejoined with the elected subject-matter upon allowance of elected subject-matter.

Turning now to the substance of the Office Action, claim 2 stands objected to

because the Examiner sees it as necessary to change "average molar weight  $M_w$ " to -- weight average molecular weight  $M_w$ --, and requires appropriate correction. Applicants are grateful to the Examiner for calling this to their attention, and have amended the claim accordingly. The objection should now be withdrawn.

Claim 1 stands rejected under 35 U.S.C. 112, second paragraph, because the Examiner views the expression "...is substantially free of polar groups..." as indefinite. This claim has been amended to substitute --is substantially free of carboxyl or hydroxyl groups--. It is believed that this amendment obviates the rejection, and the rejection of claim 1 under 35 U.S.C. 112, second paragraph should now be withdrawn.

Claims 1, 3-9, 16 and 17 stand rejected under 35 U.S.C. 103(a) as obvious over Massow et al (US 5,194,455) in view of Guldbrandsen et al. (US 6,472,025). The Examiner sees Massow as disclosing an acrylate-based hotmelt pressure sensitive adhesive comprising a polyacrylate component similar to Applicants', and sees Guldbrandsen as disclosing the use of a filler such as chalk. From this, the Examiner concludes that it would be obvious to use Guldbrandsen's chalk in Massow's hotmelt adhesive, to somehow arrive at Applicants hotmelt pressure sensitive adhesive.

Massow's polyacrylate is a very specific copolymer of an acrylate monomer with N-tert.-butylacrylamide; whereas Guldbrandsen is specific to low molecular weight acrylate hotmelts. Moreover, Guldbrandsen does not single-out chalk as being any different than any other filler, or as having any special advantages when combined with any special polyacrylate.

Applicants, however, have discovered and, by their examples, demonstrate unexpected results for hotmelt pressure-sensitive adhesives meeting the parameters of Claim 1. More specifically, Applicants have made the surprising and unexpected discovery that the addition of calcium carbonate to their specific hot-melt pressure sensitive adhesive produces an unforeseen improvement in the shrinkback properties of the adhesive. This is demonstrated by Applicants' Examples, as shown by the data of Table 1, found on page 20. In this regard, it should be noted that the only difference between reference examples 1 and 2 and inventive examples 3 and 4 is the presence or absence of the chalk.

In view of this demonstration of unexpected advantages, Applicants' claims cannot fairly be seen as obvious over the Massow/Guldbrandsen combination of references, and the rejection of claims 1, 3-9, 16 and 17 under 35 U.S.C. 103(a) as obvious over Massow et al (US 5,194,455) in view of Guldbrandsen et al. (US 6,472,025) should now be withdrawn.

Claim 2 stands rejected under 35 U.S.C. 103(a) as obvious over Massow et al (US 5,194,455) in view of Guldbrandsen et al. (US 6,472,025) and further in view of Lai (U.S. Pub. 2003/0120101). The Examiner relies on Lai for a molecular weight of less than 500,000. The copolymer of Lai is, however, a completely different polymer than that of Massow or Guldbrandsen, and the Examiner has not shown why anyone would want to make the polymers of Massow or Guldbrandsen in the molecular weight range of e.g. 600 – 3500 disclosed by Lai. The Examiner has not shown anything in any of

the references that would suggest this. More specifically, the Examiner has not shown any *motivation* for his proposed combination of references.

Even if, however, any product that could be derived from the Massow/Guldbrandsen combination of references were to be made in the molecular weight range disclosed by Lai, Applicants' demonstration of unexpected advantages, as discussed above, would not be overcome.

Accordingly, claim 2 cannot be seen as obvious over Massow and Guldbrandsen in further view of Lai, and the rejection of claim 2 under 35 U.S.C. 103(a) as obvious over Massow et al (US 5,194,455) in view of Guldbrandsen et al. (US 6,472,025) and further in view of Lai (U.S. Pub. 2003/0120101) should now be withdrawn.

In view of the present remarks it is believed that claims 1-29 are now in condition for allowance. Reconsideration of said claims by the Examiner is respectfully requested and the allowance thereof is courteously solicited.

#### CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Appellants request that this be considered a petition therefor. Please charge the required petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fee or credit any excess to Deposit Account  
No. 14-1263.

Respectfully submitted,  
NORRIS, McLAUGHLIN & MARCUS, P.A.

By David D. Kim  
David D. Kim  
Reg. No. 53,123

WCG/DDK/zs

875 Third Avenue - 18<sup>th</sup> Floor  
New York, New York 10022  
(212) 808-0700

I hereby certify that this correspondence is being  
transmitted via facsimile, no (703) 872-9306, to the United  
States Patent and Trademark Office, addressed to: Mail  
Stop Amendment, Commissioner for Patents, P.O. Box  
1450, Alexandria, VA 22313-1450 on March 29, 2005.

By Zsuzsa Schuster  
Zsuzsa Schuster  
Date March 29, 2005